

REMARKS

Applicant has considered and studied the Office Action dated April 26, 2007. Claims 1-22 are pending. Claims 1, 10, and 19 have been amended. Claims 1, 10, and 19 are independent claims.

It is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Claims

Claims 1, 10, and 19 have been amended to more clearly disclose the invention. It is respectfully submitted that the amendments have support in the application as originally filed and are not related to patentability.

§ 103 Rejections

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerszberg et al. ("Gerszberg '881" U.S. Pat. No. 6,359,881) in view of Gerszberg et al. ("Gerszberg '621" U.S. Pat. Appln. No. 2001/0040621). Applicant respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully noted that the Examiner asserts, at paragraph 5 on page 3 of the Office action, that Gerszberg '881 teaches "the displaying of the stored information on the display of the terminal when the terminal enters an on-hook status" and "the transmission of information to the terminal at any point in time." It is further respectfully noted that the Examiner also asserts that "it would have been obvious ... to enable information to be transmitted to the videophone while the videophone is in an on-hook condition. This is taught in the art by Gerszberg '621, wherein Gerszberg teaches a very similar videophone wherein information, advertisements, is transmitted to a videophone when it is determined that the videophone is not in use (p. 5, para. 0042) and therefore the videophone is in an on-hook condition. "

Applicant respectfully disagrees with the Examiner's interpretation of Gerszberg '881 and Gerszberg '621. First of all, contrary to the Examiner's assertion, it is respectfully submitted that Gerszberg '621 does not disclose or suggest determining that the videophone is in an on-hook condition.

It is respectfully noted that para. 0042 in Gerszberg '621 recites "... advertisements may be downloaded from the FMP 32, the NSP 36, and/or any other service provider or device on a periodic basis and/or during low-use times such as the middle of the night or when the videophone is not being used. Alternatively, advertisements may be received live on an as-needed basis from any of the above-mentioned devices. ..." However, it is further respectfully noted that nowhere in Gerszberg '621 does it disclose or suggest a step of determining a call status of each of a plurality of terminals based on call status information included in call setup information before transmitting stored information to each of the plurality of terminals during an on-hook status as in the presently claimed invention.

In addition, in view of the disclosure of Gerszberg '621, lacking a step of determining a call status of each terminal based on call status information included in call setup information as in the presently claimed invention, it is respectfully submitted that it is unclear as to whether advertisements are downloaded during an on-hook status in Gerszberg '621 as asserted by the Examiner. It is further respectfully submitted that determining an on-hook status before transmitting the stored information

to each of the plurality of terminals is one of important features of the presently claimed invention.

Furthermore, it is respectfully submitted that even if the videophones disclosed in Gerszberg '881 and Gerszberg '621 may be similar in a way as asserted by the Examiner, there is at least one significant difference between the videophones of Gerszberg '881 and Gerszberg '621, which distinguishes them clearly, and thus, making it impossible to combine these two references to arrive at the presently claimed invention.

As asserted by the Examiner, the videophone of Gerszberg '881 displays the stored information on the display of the terminal when the terminal enters an "on-hook" status. However, it is respectfully noted that the Examiner is silent about the display in the videophone of Gerszberg '621, which displays advertisements on a videophone when the videophone is in use, and therefore, the videophone is in an "off-hook" status when advertisements are displayed, contrary to the videophone of Gerszberg '881, which displays the information in an "on-hook" status. Specifically, Gerszberg '621 discloses systems and methods for displaying video advertisements on a videophone when the videophone is linked to a non-video enabled telephone, i.e., when the videophone is in use for communicating with other phone, but the videophone's display is not in use and the videophone user is near the videophone during a telephone call (p. 1, para. 0009 and p. 4, para. 0039).

Therefore, Gerszberg '621, which discloses a videophone downloading (transmitting) advertisements when the videophone is not being used, i.e., in an "on-hook" status, but displaying advertisements on the videophone when the videophone is in use, i.e., in an "off-hook" status, fails to cure the deficiency of Gerszberg '881, which discloses transmitting information to a videophone at any point, i.e., in both "on-hook" and "off-hook" status, and displaying advertisement on the videophone whenever the videophone is not in active use, i.e. in an "on-hook" status. Accordingly, in view of the contradicting disclosure of Gerszberg '881 and Gerszberg '621, they fail to be combinable to arrive at the presently claimed invention, wherein the stored information is transmitted to each of a plurality of terminals during an "on-hook" status and

displayed on a display unit of each of the plurality of terminals that is in the "on-hook" status.

For the reasons above, it is respectfully asserted that independent claims 1, 10 and 19 are allowable over the cited references. It is further respectfully asserted that claims 2 -9, which depend from claim 1, claims 11 -18, which depend from claim 10, and claims 20-22, which depend from claim 19, also are allowable over the cited references.

CONCLUSION

In view of the above remarks, Applicant submits that claims 1-22 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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